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SUTHERLAND II SUTHERLAND, ASBILL & BRENNAN, LLC 999 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER COLBERT, ELLA	
			ART UNIT 3694	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/734,694

**Applicant(s)**

GANESAN, RAYI

**Examiner**

Ella Colbert

**Art Unit**

3694

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 60-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 60-101 is/are rejected.
- 7) ☒ Claim(s) 78, 97, 100, and 101 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE-C/3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 60-101 are pending. Claims 60, 61, 69-76, 78-80, 92, 97, and 99 have been amended and claims 100 and 101 have been added in this communication filed 12/11/09 entered as Response After Non-Final Action (Notice of Informal or Non-responsive amendment) and new or additional drawings.
2. The Specification Objection is hereby withdrawn in view of Applicant's amendment to the specification. .
3. The Drawings Objections are hereby withdrawn in view of Applicant's submission of replacement drawings.
4. The Claim objections are hereby withdrawn in view of Applicant's amendments to the claims.
5. The 35 USC 112, Second Paragraph Rejection for claims 60, 79, and 99 in the Office Action mailed 5/26/09 have been overcome and are hereby withdrawn. However, there are remaining 35 USC 112, second paragraph rejections remaining as set forth here below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 60, 69, 70, 71- 73, 75, 76, 78, 79, 89, 92, and 99 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 60 as

amended recites "accessing, by the clearinghouse ... identifying the payee, stored billing information from at least one database;". It is vague and indefinite as to what Applicant is trying to claim in this claim limitation as written. Does Applicant mean "accessing, by the clearinghouse ... identifying the payee by the stored information from the at least one database" or "... identifying the payee by using the stored information from the at least one database"? Claims 73, 79, 92 and 99 have a similar problem. Claim 60 also recites "'database'" and in claim 70 recites "data store". There appears that the claims 60 and 99 and 70 and 89 are not in agreement. It is unclear whether the "database" and the "data store" are two different storages or the same storages. A database is often referenced as a "data store". A database by definition is defined as "a collection of data stored on a computer readable medium such as a disk, that can be used for more than one purpose".

Claim 69 recites "identifying, by the clearinghouse, second information identifying the payee". It is unclear how there can be second information when nothing has been mentioned about first information in the body of the claim. First bill information appears to be only in the preamble of the claim. Claims 71, 73, 88, 90, and 92 have a similar problem.

Claim 72 recites "The method of claim 71, wherein receiving second bill information associated with bills of the payee comprises second bill information associated with bills of the payee subsequent to the receipt ..." which are redundant claim limitations. The claim would be better recited as "The method of claim 71, wherein receiving second bill information associated with bills of the payee comprises

the bills of the payee subsequent to the receipt ..." Claims 75, 76, and 78 have a similar issue.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 60-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,884,288) Chang et al, hereafter Chang in view of (US 6,493,685) Ensel et al, hereafter Ensel and further in view of (US 6,173,272) Thomas et al, hereafter Thomas. Claims 60 and 99. Chang discloses, A method, a system, and a computer program product comprising: executing computer-implemented instructions performed by one or more processors for: receiving, by a bill presentment and payment central clearinghouse, a request that is not associated with electronic bill presentment, the request comprising information identifying a payee of the payor, wherein the payor has not previously activated electronic bill presentment from the payee through the clearinghouse (col. 1, lines 30-

48-Background of the Invention); accessing, by the clearinghouse and based on at least a portion of the received information identifying the payee, stored billing information from at least one database (col. 8, lines 21-55) and identifying, by the clearinghouse from the accessed billing information, a bill presentment information associated with the payee (col. 8, line 56-col. 9, line 25). Chang did not expressly disclose the request comprising information identifying a payee of the payor where the payor has not previously activated electronic bill presentment from a payee. Ensel discloses, the request comprising information identifying a payee of the payor where the payor has not previously activated electronic bill presentment from a payee (col. 3, lines 42-col. 4, line 16 and col. 7, lines 19-35 and Fig. 2 (330). Chang failed to disclose, generating, by the clearinghouse, a notification of the identified bill presentment information associated with the payee; and transmitting, by the clearinghouse to the payor, the generated notification. Thomas discloses, generating, by the clearinghouse, a notification of the identified bill presentment information associated with the payee (col. 12, line 37-col. 13, line 9); and transmitting, by the clearinghouse to the payor, the generated notification (col. 13, lines 4-9, col. 14, line 566-col. 15, line 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Thomas in Chang because such an incorporation would allow Chang to have a method and system that provides electronic bill presentment that permits billers to present bills to payors and to transfer funds between a payor and a payee. Claims 61 and 80. Chang failed to disclose, wherein identifying a bill presentment information associated with the payee comprises: matching the at least a portion of the

received information identifying the payee to at least a portion of the billing information; and determining, subsequent to the matching, whether the bill presentment information is available in the billing information. Thomas discloses, wherein identifying a bill presentment information associated with the payee comprises: matching the at least a portion of the received information identifying the payee to at least a portion of the billing information (col. 15, lines 1-65); and determining, subsequent to the matching, whether the bill presentment information is available in the billing information (col. 19, line 27-col. 20, line 38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Thomas in Chang because such an incorporation would allow Chang to have a method and system that provides electronic bill presentment that permits billers to present bills to payors and to transfer funds between a payor and a payee.

Claims 62 and 81. Chang discloses, wherein identifying a bill presentment information associated with the payee comprises identifying an indication that the payee is an electronic biller capable of providing electronic bill presentment to the payor through the clearinghouse (col. 1, lines 18-51).

Claims 63 and 83. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payor, a request to activate electronic bill presentment of bills for the payor from the payee through the clearinghouse; and initiating activation of electronic bill presentment in response to the received request (col. 2, lines 7-30).

Claims 64 and 83. Chang discloses, wherein initiating activation of electronic bill presentment comprises: transmitting, by the clearinghouse to the payee, a notification of the request to activate electronic bill presentment (col. 2, lines 39-67).

Claim 65. Chang discloses, The method of claim 60, wherein identifying a bill presentment information associated with the payee comprises identifying an indication that an electronic bill from the payee for the payor is available through the clearinghouse (col. 4, lines 13-67).

Claims 66 and 85. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payor, a request to receive the electronic bill; and transmitting, by the clearinghouse to the payor, the electronic bill (col. 8, lines 4-25).

Claims 67 and 86. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: transmitting, by the clearinghouse to the payee, a notification of the request to receive the electronic bill (col. 2, lines 7-14).

Claims 68 and 87. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payor, a request to pay the electronic bill; and remitting, by the clearinghouse to the payee, a payment for the electronic bill (col. 1, lines 41-48) and col. 1, lines 49-51).

Claims 69 and 88. Chang discloses, wherein the information identifying the payee comprises receiving first information identifying the payee, and further comprising



executing computer-implemented instructions performed by the one or more processors for: identifying, by the clearinghouse, second information identifying the payee; and transmitting, by the clearinghouse to the payor, the second information identifying the payee, wherein the notification is transmitted to the payer with the second information identifying the payee (col. 2, lines 1-30).

Claims 70, 89, and 92. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: storing, by the clearinghouse in a data store, the information identifying the payee (col. 5, line 42-col. 6, line 18), wherein the identifying a bill presentment information comprises identifying a bill presentment information (i) subsequent to storing the information identifying the payee, or (ii) prior to storing the information identifying the payee (col. 5, lines 1-42).

Claims 71 and 90. Chang failed to disclose, wherein accessing stored billing information from at least one database comprises accessing first bill information from at least one database, and further comprising executing computer-implemented instructions performed by the one or more processors for: receiving, by the clearinghouse from the payee, second bill information associated with bills of the payee; identifying, by the clearinghouse from at least a portion of the second bill information, an electronic bill of the payee that is available for the payor through the clearinghouse; and transmitting, by the clearinghouse to the payor, a notification of the available electronic bill of the payee. Thomas discloses, wherein accessing stored billing information from at least one database comprises accessing first bill information

from at least one database, and further comprising executing computer-implemented instructions performed by the one or more processors for:

receiving, by the clearinghouse from the payee, second bill information associated with bills of the payee; identifying, by the clearinghouse from at least a portion of the second bill information, an electronic bill of the payee that is available for the payor through the clearinghouse; and transmitting, by the clearinghouse to the payor, a notification of the available electronic bill of the payee (col. 9, line 15-col. 10, line 57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Thomas in Chang because such an incorporation would allow Chang to have a method and system that provides electronic bill presentment that permits billers to present bills to payors and to transfer funds between a payor and a payee.

Claims 72 and 91. Chang discloses, wherein receiving second bill information associated with bills of the payee comprises receiving second bill information associated with bills of the payee subsequent to the receipt of the information identifying the payee (col. 8, lines 21-51).

Claims 73 and 92. Chang discloses, wherein identifying a bill presentment information associated with the payee comprises identifying first bill presentment information, wherein generating a notification comprises generating a first notification, and further comprising executing computer-implemented instructions performed by the one or more processors for: determining, by the clearinghouse, information identifying the payor (col. 1, lines 41-48); accessing, by the clearinghouse and based on at least a portion of the

determined information identifying the payor, stored electronic billing information for the payor from the at least one database (col. 5, lines 1-42); and identifying, by the clearinghouse from the accessed electronic billing information for the payor, an electronic bill for the payor that is available to the payor through the clearinghouse (col. 9, line 15-col. 10, line 57); generating, by the clearinghouse based at least in part on the identification of the electronic bill for the payor, a second notification of a second bill presentment information; and transmitting, by the clearinghouse to the payor, the second notification (col. 13, line 4-col. 14, line 67).

Claims 74 and 93. Chang and Thomas failed to disclose, wherein identifying a bill presentment information associated with the payee comprises identifying first bill presentment information associated with a first payee, and wherein identifying an electronic bill for the payor comprises identifying an electronic bill for the payor that is a bill of a second payee different than the first payee. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the payee as the first payee and to have the electronic bill for the payor to be a bill of a second payee and to be different from the first payee because this would be a different identifier to keep the first payee separate from the second payee and assist in the ability to identify each payee's bills.

Claims 75 and 94. Chang discloses, wherein generating a second notification of a second bill presentment information comprises generating a second notification of a second bill presentment information that comprises an indication that the second payee

is an electronic biller capable of providing electronic bill presentment to the payor through the clearinghouse (col. 6, line 62-col. 7, line 62).

Claims 76 and 95. Chang discloses, wherein generating a second notification of a second bill presentment information comprises generating a second notification of a second bill presentment information that comprises an indication that the electronic bill from the second payee for the payor is available through the clearinghouse (col. 9, lines 26-67).

Claims 77 and 96. Chang discloses, further comprising executing computer-implemented instructions performed by the one or more processors for: storing an indication of the identified payee in a payee list associated with the payor (col. 6, line 56-col. 7, line 8).

Claim 79. Chang discloses, A system, comprising: a communications interface associated with a bill presentment and payment central clearinghouse and operable to (i) receive a request that is not associated with electronic bill presentment, the request comprising information identifying a payee of the payor, wherein the payor has not previously activated electronic bill presentment from the payee through the clearinghouse, and (ii) transmit a notification to the payor; and at least one processor (col. 6, lines 28-35) associated with the clearinghouse and operable to (i) receive the information identifying the payee from the communications interface (col. 5, line 50-col. 6, line 8 and lines 28-35), (ii) access, based on at least a portion of the information identifying the payee, stored billing information from at least one database, (iii) identify, from the accessed billing information, a bill presentment information associated with the

payee, (iv) generate the notification to the payee, the notification including the identified bill presentment information, and (v) direct the communications interface to transmit the notification to the payor (col. 5, lines 43-48). The type of information identifying the payee and the billing information which is just data is given very little patentable weight because it is considered "non functional descriptive material that cannot render nonobvious an invention that would have otherwise been obvious". *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ 2d, 1862, 1864 (Fed. Cir. 2004). *In re Gulak*, 703 F.2d 1381, 1385, 217 USPQ401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Statements of intended use do not serve to distinguish structure over the prior art. See *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); *In re Yanush*, 4778 F.2d 958, 959, 152 USPQ 235, 238 (CCPA 1967).

#### ***Allowable Subject Matter***

Claims 78, 97, 100, and 101 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claims 78 and 97, storing an indication of the identified payee in a payee list comprises storing an indication in a payee list that comprises multiple payees identified by the payor, and further comprising executing computer-implemented instructions performed by the one or more processors for: transmitting, by the clearinghouse to the

payor, a presentation of the payee list, wherein the presentation includes the generated notification of the bill presentment information, Claims 100 and 101, receiving a request comprises receiving one of a payment request or a request to add a payee to a pick list associated with the payor.

### ***Response to Arguments***

Applicant's arguments filed 12/11/09 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Chang does not teach or suggest the identification of bill presentment information utilizing identifying information for a payee that is received in a request that is not associated with electronic bill presentment has been considered but is not persuasive. Response: Claim 60 as amended recites "receiving ..., a request that is not associated with electronic bill presentment, the request comprising information identifying a payee of the payor, wherein the payor has not previously activated electronic bill presentment from the payee through the clearinghouse". The claim limitation does not specifically recite "identification of bill presentment information utilizing identifying information for a payee that is received in a request that is not associated with electronic bill presentment". However, this argument is considered moot in view of the amendment to the claim. It is suggested that Applicant have the claim limitation worded as "identification of bill presentment information utilizing identifying information for a payee that is received in a request that is not associated with electronic bill presentment" as argued.

Issue no. 2: Applicant argues: Thomas also fails to teach or suggest "receiving identification of bill presentment information utilizing identifying information for a payee that is received in a request that is not associated with electronic bill presentment" has been considered but is not persuasive. Response: Thomas was not used to reject these claim limitations. Also, Applicant is arguing the amendments to the claim. Therefore, this argument is considered moot.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and

unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process").

Once the claim rejections are overcome and a new search is performed, if there are no other outstanding issues and no new art is found to reject the claims the application will be passed to issue.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741.



The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3694

March 11, 2010